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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/880,039

06/14/2001

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011350-276

5950

7590 04/02/2007
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EXAMINER

DUONG, THOMAS

ART UNIT

PAPER NUMBER

2145

MAIL DATE

DELIVERY MODE

04/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/880,039

Applicant(s)

KATSUDA, TAKEO

Examiner

Thomas Duong

Art Unit

2145

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 14-31 and 37-47.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


JASON CARDONE
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Arguments presented are not persuasive. Please see the attachment sheets.

DETAILED ACTION

Response to Argument

1. The Applicant's arguments filed on March 3, 2007 have been fully considered, but they are not persuasive.
2. With regard to claims 15 and 37-43, the Applicant points out that,
 - *After carefully considering the Examiner's arguments on pages 24-28 of the Office Action, the characterization of the Miller system, the quoted Column 3 language, and the other cited column and lines, Applicant was unable to find the claimed feature of a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device in the Miller patent.*

However, the Examiner finds that the Applicants' arguments are not persuasive because Miller discloses, *"upon receipt of the message, the network determines an appropriate action to take with respect to the message based upon a profile of the subscriber. The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network"* (Miller, col.1, lines 52-58). Hence, Miller teaches of determining the appropriate notification and delivery method, notifying the subscriber of the impending message, and, finally, delivering the message to the subscriber. Miller discloses in *figures 4(j), 4(n), 4(q), and 4(t)* the possible delivery methods determined by the system such as *"mail forwarding"* via the internet and the e-mail system, *"SMS"* via the display 412 of

the handset 411, "fax" via a specified facsimile machine, or "voice" via the public switched telephone network and notifying the subscriber of these selected available methods. In other words, Miller teaches of the system presenting the subscriber with the system selected outputting methods. Miller discloses, *"in this instance, Thomas chooses to receive more of the main body using SMS. That is, more of the main body will be sent to the handset 411 as text. FIG. 4(k) shows that the handset has received more of the main body of the e-mail text that is displayed in the display 412"* (Miller, col.5, lines 50-54). Hence, Miller teaches of the subscriber confirming with the system in using SMS as the selected delivery method via the display 412 of the handset 411. In other words, Miller teaches of the system presenting SMS as one of the selected delivery methods to the subscriber and that the subscriber confirming with the system of using SMS as the delivery method via the display of the handset.

3. With regard to claims 14-15 and 31, the Applicant points out that,

- *However, as in the rejection of claim 15, the claimed feature of an E-mail identifying multiple prospective image output devices is not disclosed. None of the citations describe the claimed step of transmitting an E-mail identifying multiple prospective image output devices, only the selective sending of a receipt notification.*
- *The system of Miller does not provide a E-mail identifying multiple prospective image output devices as recited in independent claim 14. As stated in column 1, lines 54-58 of the Miller patent, "The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the*

subscriber to the network" (emphasis added). This is not the same as the claimed feature.

However, the Examiner finds that the Applicants' arguments are not persuasive because Miller discloses in *figures 4(j), 4(n), 4(q), and 4(t)* the possible delivery methods determined by the system such as "mail forwarding" via the internet and the e-mail system, "SMS" via the display 412 of the handset 411, "fax" via a specified facsimile machine, or "voice" via the public switched telephone network and notifying the subscriber of these selected available methods. In other words, Miller teaches of the system presenting the subscriber with the system selected outputting methods. Miller discloses, "in this instance, Thomas chooses to receive more of the main body using SMS. That is, more of the main body will be sent to the handset 411 as text. FIG. 4(k) shows that the handset has received more of the main body of the e-mail text that is displayed in the display 412" (Miller, col.5, lines 50-54). Hence, Miller teaches of the subscriber confirming with the system in using SMS as the selected delivery method via the display 412 of the handset 411. In other words, Miller teaches of the system presenting SMS as one of the selected delivery methods to the subscriber and that the subscriber confirming with the system of using SMS as the delivery method via the display of the handset.

4. With regard to claim 44, the Applicant points out that,
 - Independent claim 44 recites a processor that is responsive to receipt of an E-mail addressed to a certain destination through the communication interface, for generating at least one E-mail containing a notification of the receipt of the E-mail and information on at least one output device to which at least a part of the E-

mail is .to be outputted, and for controlling the communication interface to send the generated one E-mail to said certain destination. (Emphasis added). The cited portions of the Miller patent do not disclose or suggest a processor for generating at least one E-mail containing information on at least one output device to which at least part of the E-mail is to be output as recited in independent claim 14.

However, the Examiner finds that the Applicants' arguments are not persuasive because Miller discloses in *figures 4(j), 4(n), 4(q), and 4(t)* the possible delivery methods determined by the system such as "mail forwarding" via the internet and the e-mail system, "SMS" via the display 412 of the handset 411, "fax" via a specified facsimile machine, or "voice" via the public switched telephone network and notifying the subscriber of these selected available methods. In other words, Miller teaches of the system presenting the subscriber with the system selected outputting methods. Miller discloses, *"in this instance, Thomas chooses to receive more of the main body using SMS. That is, more of the main body will be sent to the handset 411 as text. FIG. 4(k) shows that the handset has received more of the main body of the e-mail text that is displayed in the display 412"* (Miller, col.5, lines 50-54). Hence, Miller teaches of the subscriber confirming with the system, which would have included a processing unit as known in the art, in using SMS as the selected delivery method via the display 412 of the handset 411. In other words, Miller teaches of the system presenting SMS as one of the selected delivery methods to the subscriber and that the subscriber confirming with the system of using SMS as the delivery method via the display of the handset.